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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,049	10/07/2003	Jerome C. Bressi	SYR-HDAC-5002-U	5114
32793	7590	04/24/2006	EXAMINER	
TAKEDA SAN DIEGO, INC. 10410 SCIENCE CENTER DRIVE SAN DIEGO, CA 92121			DAVIS, BRIAN J	
			ART UNIT	PAPER NUMBER
			1621	

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	Applicant(s)	
10/681,049	BRESSI ET AL.	
Examiner	Art Unit	
Brian J. Davis	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on 23 February 2006.
- 2a)  This action is FINAL.                      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4)  Claim(s) 2-16, 18, 19, 21-37 and 39-124 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) 2-10, 12, 14-16, 18, 19, 22-31, 33, 35-37, 39-50, 52, 54-69, 71, 73-79, 81-90, 92 and 94-124 is/are allowed.
- 6)  Claim(s) 11, 13, 21, 32, 34, 51, 53, 70, 72, 80, 91 and 93 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on 07 October 2003 is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a)  All    b)  Some \*    c)  None of:
- Certified copies of the priority documents have been received.
  - Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## DETAILED ACTION

### *Clarification*

The examiner points out for clarity of the record that no claims have been withdrawn, despite applicant's having labeled some claims as such in the response.

### *112 Rejections, NEW*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The dependency of the claim is unclear since it depends from canceled claim 1.

Claims 11, 13, 21, 32, 34, 51, 53, 70, 72, 80, 91 and 93 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For instance, claim 13 recites the limitation “-C(O)H and -C(O)-C<sub>1-3</sub> alkyl” in the definition of R<sub>3</sub>. There is insufficient antecedent basis for this limitation in the claim. The independent claim, claim 101, limits R<sub>3</sub> to “hydrogen, a substituted or unsubstituted straight chain C<sub>1-12</sub> alkyl, C<sub>2-12</sub> aminoalkyl or C<sub>2-12</sub> oxaalkyl and a substituted and unsubstituted 3-8 membered ring...”. Analysis of the remaining claims is similar. This

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rejection should have been made in the previous Office Action. The examiner regrets the error.

### ***102 Rejections Withdrawn***

The rejection of claims 1-119, in so far as they read on the species defined in the previous Office Action, under 102(b), has been overcome by applicant's amendment. The amendment cancels claims 1, 17, 20 and 38. With respect to the remaining claims, the claims have been narrowed such that they no longer read on the cited prior art.

### ***Allowable Subject Matter***

Applicant having overcome the outstanding rejection, the search was therefore expanded as called for under current Office Markush practice, a compound-by-compound search. This resulted in all remaining species being searched and deemed free of the prior art. Claims 1-10, 12, 14-16, 18, 19, 22-31, 33, 35-37, 39-50, 52, 54-69, 71, 73-79, 81-90, 92 and 94-124 are allowed.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**BRIAN DAVIS**  
**PRIMARY EXAMINER**

Brian J. Davis  
April 17, 2006